

REMARKS

Claims 1-12 were pending in this application.

Claims 7 and 8 are canceled, without prejudice. Claims 1 and 4 are amended to incorporate part of the subject matter of claim 4 into claim 1. Claims 5 and 11 are amended to correct a minor editorial problem. No new matter is added in this amendment.

Accordingly, claims 1-6 and 9-12 are pending in the subject application.

Applicants request reconsideration of the pending claims in light of the above claim amendment taken along with the following remarks.

Claim Rejection under 35 U.S.C. §103

Claims 1-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 09-127691 to Gokochi et al (hereinafter Gokochi) in view of its English language abstracts.

The March 31, 2005 Office Action (hereinafter Office Action) urged that Gokochi disclose a photosensitive composition containing a resin having acid decomposable groups, an optical acid generating agent and a naphthol novolak compound whose mol. wt. is ≤ 2000 . The acid-decomposable groups are, e.g., tert-butyl ester, tert-butoxycarbonyl, trimethylsilyl ether, trimethylsilyl ester, tetrahydropyranyl ether or tetrahydropyranyl ester. An arbitrary compound generating an acid when irradiated with chemical radiation may be used as the optical acid generating agent. The naphthol novolak compound is a novolak compound obtained by condensing naphthol or its derivative with a carbonyl compound. The reference teaches that the compound may be combined with a phenol resin. Based on a spot translation by a USPTO staff member, the resin may contain a phenol derivative as a cross-linking agent. The crosslinker may have its OH groups replaced by protective groups (see 6 on page 30). On these premises, the Office Action urged that given the teachings of the reference, and the knowledge that phenolic resins are preferred for the bottom layer of bi-layer resist systems, it would have been obvious to one of ordinary skill in the art to prepare the material of Gokochi by choosing to employ a phenol compound in combination with the naphthol compound as the bottom of a bi-layer resist system with reasonable expectation of achieving a material having high resolution. (see, Office Action at page 2 bridging page 3). Applicants respectfully traverse this rejection.

The motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. There is no such teaching or suggestion in Gokochi relative to applicants' claim 1, as amended, and claim 9.

There is no teaching or suggestion in Gokochi for incorporating a *thermal* acid generator (TAG) in the resin, as in applicants' claim 1, as amended, and claim 9. Gokochi discloses a photosensitive composition containing a resin having acid decomposable groups, an *optical* acid generating agent and a naphthol novolak compound whose mol. wt. is ≤ 2000 . Gokochi does not disclose a *thermal* acid agent as part of its photosensitive composition. Accordingly, claim 1, as amended, and claim 9 are not rendered obvious in view of Gokochi.

Applicants respectfully request reconsideration and withdrawal of the rejection to claims 1 and 9, and claims 2-6, and 10-12 depended respectively thereon.

Conclusion

In summary, applicants respectfully submit that the present application is in condition for allowance. Early notice to that end is earnestly solicited.

If a telephone conference would be of assistance in furthering prosecution of the subject application, applicants request that the undersigned be contacted at the number below.

Respectfully submitted,



Bernard Lau
Reg. No. 38,218
Attorney for Applicants

F. Chau & Associates, LLC
130 Woodbury Road
Woodbury, NY 11797
Tel: (516) 692-8888
Fax: (516) 692-8889